

REMARKS

This Amendment is made in response to the Official Action mailed September 1, 2000. Reconsideration and withdrawal of the rejections of this application are respectfully requested in view of the amendments and remarks.

Claims 10 to 23 are pending. No new matter is added. Amendments to claims 10 to 19 are made without prejudice or any intention to create any estoppel as to equivalents. Support for amendments to claims 10 to 19 could be found in the originally filed specification. Newly presented claims 20 to 23 could also be found in the originally filed specification. Applicants reserve the right to pursue canceled subject matter in a divisional application. No new matter is added.

Any additional fees occasioned by this paper or the claims herein, or any overpayment therein, may be charged or credited to Deposit Account No. 50-0320.

Claims 9 to 19 are rejected under 35 U.S.C. §112, second paragraph, as said to be indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (Office Action, at 2 to 3). Additionally, claims 17 to 19 are rejected because they are said to provide for the use of the mono- or multilayer film of claim 9. (Office Action, at 3). Furthermore, claims 17 to 19 are rejected under 35 U.S.C. §101 because the claims are said to recite a use, without setting forth any steps involved in the process, results in an improper definition of a process. (Office Action, at 4).

The Examiner is thanked for her helpful suggestion concerning claim 9 and will note, by this Amendment, the pending claims have been amended accordingly.

The claims have been amended and rewritten without prejudice or any intention to create any estoppel as to equivalents.

Reconsideration and withdrawal of the rejections of claims 9 to 19 under 35

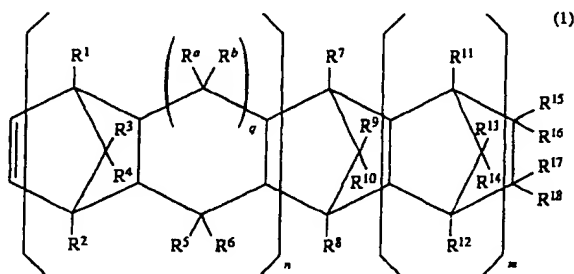
U.S.C. §112, second paragraph and claims 17 to 19 under §101 are respectfully requested.

Claims 9 to 14 and 17 to 19 are rejected under 35 U.S.C. §102(b) as being allegedly clearly anticipated by Hirose et al., U.S. Patent No.: 5,532,030 ("Hirose"). In addition, claim 15 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Hirose et al., U.S. Patent No.: 5,532,030 ("Hirose"). (Office Action, at 4 to 7).

These rejections will be addressed collectively. It is submitted that these rejections are unwarranted and reconsideration and withdrawal of same is respectfully requested.

The present invention teaches a mono- or multilayer film, where the film consists of a cycloolefin copolymer or mixtures of cycloolefin copolymers and one or more thermoplastics, and where, at 85% relative humidity and a temperature of about 23⁰C, the film has a water vapor permeation of $\leq 0.035 \text{ g}^* \text{ mm/m}^2 \text{ d}$, a puncture resistance of $\leq 300 \text{ N/mm}$ and a thickness of $\leq 100 \mu\text{m}$.

Hirose, on the other hand relates to A polyolefin multilayer laminate in which a first layer (A) made of a cycloolefin-based resin, such as an ethylene/cycloolefin random copolymer resulting from copolymerization of ethylene and a cycloolefin represented by the formula (1) given below, or a cycloolefin-based resin blend and a second layer (B) made of an olefin (co)polymer or a composition containing it are laminated. This laminate can be used as a packaging material which is superior in the interlayer adhesion, shapability, moistureproof property, transparency, flexibility, easiness of hand-cutting, heat-sealability and dead-hold property. Formula (1)



in which n and q are 0 or 1, m is 0 or any positive integer, R^1 - R^{18} , and R^a and R^b denote each H, a halogen atom or a hydrocarbon group, wherein R^{15} - R^{18} may form, by combining with each other, a monocyclic or polycyclic ring, which may have double bond(s), and wherein R^{15} - R^{16} may have terminal-located alkylidene group.

Thus, Hirose relates to a polyolefin multilayer laminate in which at least one layer consists of a cycloolefin-based resin (*See* Abstract of the Hirose patent). Furthermore mono- or biaxial stretching of such films as well as use of such films as a packaging material is disclosed.

To the contrary, claim 9 of the instant patent application claims a mono- or multilayer film comprising a cycloolefin polymer and (emphasis added) possessing a specific set of properties (water permeation, puncture resistance and thickness). In particular, the puncture resistance of the films is obtained by a selected processing of the film; such procedure and films with such properties are neither disclosed in nor obvious from the Hirose et al. patent.

Additionally, Hirose only generally mentions that its films can be stretched mono- or biaxially (*See* Col. 34, lines.42-45). Stretching of films is generally known in the art. Thus Hirose does not disclose more or less what someone skilled in the art would expect to do after preparation of the films. But the specific combination of properties and the specific manner of treatment of the instantly claimed films is neither taught nor disclosed in Hirose. Accordingly, the present invention could not possibly have been anticipated by or obvious in view of Hirose.

The films according to the present invention are preferably used for blister packs, and especially preferred as a backing film for blister packs (*See* specification page 1, lines 7-10). For this application the film must be easy to puncture (*See* specification page 3, lines.3-5). In order to achieve the desired puncture resistance (as claimed and defined in claim 9) a specific orientation has to be given to the films (*See* specification page 11, lines 18-24). Moreover, the mechanical properties of the film have to be selected properly in order to ensure reliable

processing (*See comp. page 11, lines 24-26*). In addition, Hirose only relates to multilayer films whereas the present invention teaches and claims both mono- and multilayer films.

According to the disclosure in the instant application, if the stretching conditions are not chosen properly, the claimed puncture resistance is not achieved. *See Examples 2 and 9 to 10*. This requirement is lacking in Hirose's disclosure. Accordingly, the present invention is clearly patentable over Hirose.

Consequently, the present invention is neither anticipated by nor obvious over Hirose.

A prior art reference must contain all of the elements of the claimed invention to be said to properly "anticipate" the claimed invention. Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q.2d, 1766 (Fed. Cir. 1987). To constitute anticipation, all material elements of a claim must be found in one prior art source. In re Marshall, 198 U.S.P.A. 344 (C.C.P.A. 1978); In re Kalm, 154 U.S.P.Q. 10 (C.C.P.A. 1967).

Accordingly, the Office Action did not meet its burden in showing that Hirose contains every limitation of rejected claims 9 to 14 and 17 to 19.

In view of the foregoing, Applicants urge that Hirose does not contain all of the elements of the claimed invention and thus fail to anticipate the claimed invention. It is submitted that the rejection under 35 U.S.C. 102(b), based on Hirose is unwarranted and should be withdrawn.

Applicants likewise maintain that the rejection of claim 15 under 35 U.S.C. § 103(a), based on Hirose, is unwarranted. Despite the statements in the Official Action, it is urged that one skilled in the art, using Hirose, would not be led to Applicants' claimed invention.

There can be no obviousness when the reference teaches away from the invention at hand. In re Fine, 5 U.S.P.Q.2d 1596,1599 (Fed. Cir. 1988)(citing W. L. Gore & Assoc. v. Garlock, Inc., 220 U.S.P.Q. 303,311 (Fed. Cir. 1983)).

Furthermore, Hirose only relates to multilayer films whereas the present invention teaches and claims a mono- or a multilayer film.

In this regard, whether a particular product or method might be "obvious to try" is not a legitimate test of patentability. In re Fine, 5 U.S.P.Q.2d 1596, 1599 (Fed.Cir. 1988); Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed.Cir. 1986); Ex parte Old, 229 U.S.P.Q. 196, 200 (PTO Bd. App. & Int. 1985). "Obvious to try" is not the standard.

Consequently, the Section 103 rejection cannot stand. The present invention is neither taught nor suggested by Hirose and Hirose fails to provide either the desirability or modification required by Fine.

Applicants therefore submit that the rejection of claim 15 under 35 U.S.C. § 103(a) based on Hirose, is unwarranted and should be withdrawn.

In view of the foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. Section 102(b) and Section 103 are respectfully requested.

Claims 9 to 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1 to 5 of copending application no.: 08/994,863. (Office Action, at 8).

Applicants respectfully disagreed because there are distinctions between the pending claims of the current application and the pending claims of USSN 08/994,863 as indicated by page 8 of the September 1, 1999 Office Action.

However, the Examiner's attention is respectfully invited to review M.P.E.P. § 804, which provides that if a "provisional" double patenting rejection is the only rejection

remaining in an application, the Examiner should withdraw that rejection and permit the application to issue as a patent; the provisional double patenting rejection in the other application should remain and should be converted into a double patenting rejection when the first application issues (Manual of Patent Examining Procedure § 804, at 800-14, 6th Ed., July 1996 rev).

Reconsideration and withdrawal of the provisional rejection to claims 9 to 14 are respectfully requested in view of the remarks herewith.

Pursuant to 37 C.F.R. §§1.136(a) and 1.17(a)(3), Applicants hereby request that the term for reply to the September 1, 1999 Office Action be extended three months, i.e., up to and including March 1, 2000. A check for \$870.00 is enclosed herewith.

Any additional fee occasioned by this paper, including with respect to the claim amendments herewith and the petition for extension of time herein accompanying this paper, or any overpayment in those fees, may be charged or credited to Deposit Account No. 50-0320.

In view of the amendments and remarks herewith, the present application is in condition for allowance. Early and favorable reconsideration and prompt issuance of a Notice of Allowance are earnestly solicited. If any issue remains as an impediment to allowance, an

interview is respectfully requested and the Examiner is further respectfully requested to contact the undersigned by telephone to arrange a mutually convenient time and manner for the interview.

Respectfully submitted,

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